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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,505	12/04/2003	Hideo Noyama	500.42792CX1	7165
20457 7590 06/18/2007 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			EXAMINER TRUONG, THANHNGA B	
			ART UNIT 2135	PAPER NUMBER
			NOTIFICATION DATE 06/18/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/726,505

Applicant(s)

NOYAMA ET AL.

Examiner

Thanhnga B. Truong

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Thanhnga B. Truong
AU2135

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/4/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the communication filed on December 4, 2003. Claims 1-9 are pending. At this time, claims 1-9 are rejected.

Double Patenting

2. Claims 1-9 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-10 of copending Application No. 10/445, 989 and copending Application No. 11/053, 859. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Claims 1-9 recites the claimed language that is similar to those of claims 1-10 of copending Application No. 10, 445, 989 and copending Application No. 11/053, 859.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites a certificate without any further description and/or functional descriptive material. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Art Unit: 2135

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 5 recites a certificate without any further description and/or functional descriptive material about the certificate. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hakamatsuka et al (US 5,410,642), and further in view of Yokoyama et al (US 6,789,482 B2).

a. Referring to claim 1:

i. Hakamatsuka teaches a method for issuing a certificate by using a computer, comprising the steps of:

(1) inputting individual information of a certificate issuance requester (**column 4, lines 11-21; column 5, lines 25-30 of Hakamatsuka**);

(2) writing the individual information on electronic data of a board by using characters (**column 4, lines 11-21; column 5, lines 25-30 of Hakamatsuka**);

(3) painting out a background portion of the individual information written with the characters, by using a plurality of colors according to a first predetermined rule (**column 4, lines 27-34 of Hakamatsuka**);

(4) further re-painting the background portion of the individual information written with the characters, according to a second predetermined

Art Unit: 2135

rule by using information that differs from certificate to certificate (**column 7, lines 1-16 of Hakamatsuka**);

(5) storing a certificate identification number and the information that differs from certificate to certificate (**column 3, lines 15-24 of Hakamatsuka**);

(6) entering the certificate identification number into the electronic data of the board (**column 4, lines 11-21; column 5, lines 25-30 of Hakamatsuka**); and printing the electronic data as a certificate (**column 7, lines 1-3 of Hakamatsuka**).

ii. Although Hakamatsuka teaches a method for issuing a certificate by using a computer to re-painting and/or overwriting individual information on the background pattern in the electronic data of the board with the characters as shown in (**column 7, lines 1-16 of Hakamatsuka**), Hakamatsuka is silent on the capability of predetermined the setting or configuring of rule/information on change of the background pattern caused by the character re-painting/overwriting onto the electronic data of the board. On the other hand, Yokoyama teaches this limitation in (**column 10, lines 20-30 of Yokoyama**).

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Hakamatsuka (if indeed is not inherently) with the teaching of Yokoyama for improving and enhancing print data with an embedded background image.

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Hakamatsuka with the teaching of Yokoyama for implementing the background pattern printing process (**column1, lines 15-18 of Yokoyama**).

b. Referring to claim 2:

i. Hakamatsuka further teaches:

(1) wherein the first predetermined rule specifies dividing the background portion into rectangles having equal areas, and specifies association of

Art Unit: 2135

positions of painted out portions in a rectangle with colors of portions that are not painted out (see **Figures 16(a-f) and further details in column 4-54 of Hakamatsuka**).

c. Referring to claim 3:

i. Hakamatsuka further teaches:

(1) wherein the information that differs from certificate to certificate is converted to a pattern encoded and represented by dots, and the second predetermined rule specifies extracting a position and a color of each of dots at which the background portion painted according to the first rule lies upon the pattern, creating a Voronoi diagram by using the positions of the dots, and specifies each of regions of the Voronoi diagram with the color (see **Figures 16(a-f) and further details in column 4-54 of Hakamatsuka**).

d. Referring to claim 4:

i. Hakamatsuka further teaches:

(1) entering information at time of board creation and a digital signature for guaranteeing the information at the time of board creation onto the board; and entering a digital signature for guaranteeing the individual information onto the board (see **Figure 6(b) and further details in column 7, lines 4-22 of Hakamatsuka**).

e. Referring to claim 5:

i. Hakamatsuka further teaches a certificate:

(1) wherein a certificate identification number is printed on a board (**column 4, lines 11-21; column 5, lines 25-30 of Hakamatsuka**); a background pattern unique to the certificate is printed on a part of the board by using a plurality of colors (see **Figures 16(a-f) and further details in column 4-54 of Hakamatsuka**); and individual information is overwritten on the background pattern by using characters (**column 7, lines 1-16 of Hakamatsuka**).

ii. Although Hakamatsuka teaches a method for issuing a certificate by using a computer to re-painting and/or overwriting individual information on the background pattern in the electronic data of the board with the characters as shown

in **(column 7, lines 1-16 of Hakamatsuka)**, Hakamatsuka is silent on the capability of predetermined the setting or configuring of rule/information on change of the background pattern caused by the character re-painting/overwriting onto the electronic data of the board. On the other hand, Yokoyama teaches this limitation in **(column 10, lines 20-30 of Yokoyama)**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Hakamatsuka (if indeed is not inherently) with the teaching of Yokoyama for improving and enhancing print data with an embedded background image.

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Hakamatsuka with the teaching of Yokoyama for implementing the background pattern printing process **(column1, lines 15-18 of Yokoyama)**.

f. Referring to claim 6:

i. Hakamatsuka further teaches a method for verifying a certificate issued comprising the steps of:

(1) converting the certificate to electronic data **(column 2, lines 32-36 of Hakamatsuka)**;

(2) reading out a certificate identification number on the certificate **(column 11, lines 44-54 of Hakamatsuka)**;

(3) reading out characters of individual information entered onto the certificate **(column 11, lines 44-54 of Hakamatsuka)**;

(4) painting out a background portion of the individual information with a plurality of colors according to a first predetermined rule **(column 4, lines 27-34 of Hakamatsuka)**;

(5) obtaining information that differs from certificate to certificate from the certificate identification number read out, and further re-painting the background portion of the individual information according to a second predetermined rule **(column 7, lines 1-16 of Hakamatsuka)**;

Art Unit: 2135

(6) comparing a background portion of the individual information on the certificate with the background portion created at the steps (d) and (e) **(column 11, lines 44-51 of Hakamatsuka)**; and

(7) judging the certificate to be invalid when the background portion of the individual information on the certificate does not coincide with the background portion created at the steps (d) and (e) **(column 15, lines 3-11 of Hakamatsuka)**.

g. Referring to claim 7:

i. This claim consist a certificate issuing system to implement claim 1, thus it is rejected with the same rationale applied against claim 1 above.

h. Referring to claims 8-9:

i. These claims have limitations that is similar to those of claim 6, thus they are rejected with the same rationale applied against claim 6 above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Thanhnga B. Truong
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TBT

June 10, 2007